



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/417,534	10/14/1999	ELKE BUCHA	209282.0006	7560

570 7590 08/05/2004

AKIN GUMP STRAUSS HAUER & FELD L.L.P.
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103-7013

EXAMINER

GABEL, GAILENE

ART UNIT PAPER NUMBER

1641

DATE MAILED: 08/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/417,534	Applicant(s) BUCHA ET AL.	
	Examiner Gailene R. Gabel	Art Unit 1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004 and 22 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-38, 42-47, 51-54, 56 and 57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-38, 42-47, 51-54, 56, and 57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment Entry

1. Applicant's amendment and response filed 3/22/04 is acknowledged and has been entered. Claims 36, 42-44, 46, 47, and 51-54 have been amended. Claims 35, 50, and 55 have been cancelled. Claims 56 and 57 have been added.
2. Applicant's supplemental amendment filed 4/22/04 is acknowledged and has been entered. Claims 56 and 57 have been amended.

Accordingly, claims 36-38, 42-47, 51-54, 56, and 57 are pending and are under examination.

Rejections Withdrawn

Claim Rejections - 35 USC § 112

3. The rejections of claims 35, 50, and 55 are now moot in light of Applicant's cancellation of the claims.
4. In light of Applicant's amendment and arguments, the rejection of claims 36, 42, 43, 47, and 52 under 35 U.S.C. 102(b) as being anticipated by Daniel (US 4,086,199) is hereby, withdrawn.
5. In light of Applicant's amendment and arguments, the rejection of claims 36, 42, 44, 47, 51, and 52 under 35 U.S.C. 102(b) as being inherently anticipated by DeCrosta et al. (US 4,575,539) is hereby, withdrawn.

Art Unit: 1641

6. In light of Applicant's amendment and arguments, the rejection of claims 36-38, 42-47, and 51-54 under 35 U.S.C. 102(e) as being inherently anticipated by Hubbell et al. (US 5,410,016) is hereby, withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 47, 51, and 56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 47 remains indefinite in failing to further limit the subject matter of a previous claim. Specifically, claim 47 fails to point out what is included or excluded by the claimed "composition" in comparison to the claimed "interactive system" as recited in claim 35 from which it depends, in order to render it a specific "composition".

Claim 51 is vague and indefinite in reciting, "adapted for treatment of disorders" because it is unclear how the interactive system is modified in order to perform its intended function, which is to treat the specific disorders recited.

Claim 56 is vague and indefinite in reciting, "A foodstuff comprising an interactive system comprising" because it is unclear what elements in parts a) and b) of the claim renders the recited interactive system a "foodstuff".

New Matter

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 36-38, 42-47, 51-54, 56, and 57 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

In this case, the specification does not appear to provide literal support or adequate descriptive support for the recitation of "structural element (A) ... is the ester group of the acrylate or vinylester polymer" to which the linker is attached to by a hydrogen bond. The specification at page 2-4 provides that the structural element (A) is derived from a carboxylic acid, that the structural element (A) is located in the side chain of the monomer, and that the structural element (A) is part of a polymer wherein R is an alkyl or aryl group; however, it fails to provide literal support for the recitation in question. Additionally, page 8, first full paragraph only provides a hypothetical molecular principle of the interaction that takes place between the structural element (A) and the linker. Moreover, none of the originally filed claims recited the limitation as currently recited. Recitation of claim limitations lacking literal or adequate descriptive support in the specification or originally filed claims constitutes new matter.

Prior Art

9. Claims 36-38, 42-47, 51-54, 56, and 57 are free of the prior art of record.
10. No claims are allowed.
11. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gailene R. Gabel whose telephone number is (703) 305-0807. The examiner can normally be reached on Monday, Tuesday, and Thursday, 7:00 AM to 5:00 PM.

Art Unit: 1641

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on (703) 305-3399. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-0169.

Gailene R. Gabel
Patent Examiner
Art Unit 1641
July 26, 2004 *gb*


LONG V. LE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600
07/26/04